

REMARKS

Claims 1-25 remain pending in the subject application. Claims 2-15, 17-19 and 21-24 are currently amended pursuant to the Examiner's request merely to change the preamble of each claim from "A" to "The" for the purposes of antecedent basis. Claim 16 is currently amended merely to clarify that the powder and/or discrete gel particles are obtained in accordance with the method of claim 1. Support for currently amended claim 16 can be found in at least paragraph [0016] of the subject application as published (specifically, U.S. Publ. Pat. Appln. No. 2007/0125998). As such, no new matter is added via the present Amendment. No claims are cancelled or withdrawn in the present Amendment.

The Examiner's objections/rejections are addressed in the order presented in the Office Action.

Objection of the Specification:

The Examiner objected to the specification of the subject application for including a paragraph that was not in the form of a complete sentence. The Applicants have amended the specification to correct this typographical error, thereby obviating the Examiner's objection.

Objection of Claims 2-15, 17-19 and 21-24

As a preliminary matter, it is unclear from the Office Action the claims to which the Examiner objected. The Office Action states that claims 2-15, 17-19 and 2-2 are objected to. The Applicants assume that the Examiner meant to object to claims 2-15, 17-19 and 21-24 (i.e., the dependent claims of the subject application). Clarification is respectfully requested.

The Examiner is requesting that the preamble of these claims be amended. In particular, the Examiner asserts that a preamble of a dependent claim cannot begin with “A” and must be amended to recite “The,” presumably for the purposes of antecedent basis. The Applicants respectfully point out that the MPEP expressly allows for dependent claims having a preamble beginning with “A.” Just one example is MPEP § 608.01(n), which sets forth the proper form of dependent claims, setting forth numerous examples of acceptable formats (including those for multidependent claims). Eleven distinct examples are provided, all of which are dependent claims and begin with “ Δ gadget . . .” Clearly, the MPEP contemplates and allows for such claims. Notwithstanding the above, the Applicants have amended these claims pursuant to the Examiner’s request to advance the subject application to allowance.

Rejection Under 35 U.S.C. § 112, ¶2

Claim 16 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards and the invention. In particular, the Examiner rejected claim 16 for including the term “obtainable” which, in the Examiner’s opinion, broadens the claim.

The Applicants note that claim 16 is a product-by-process claim, and further note that the Federal Circuit has held that there is no distinction between the phrase “obtainable by” and the phrase “obtained by” in the scope of product-by-process claims (see, e.g., *Abbott Laboratories v. Sandoz, Inc.*, 566 F.3d 1282 (Fed. Cir. 2009)). However, the Applicants have

amended claim 16 to recite “obtained by” rather than “obtainable by,” rendering the Examiner’s rejection under 35 U.S.C. § 112, second paragraph, moot.

Rejection Under 35 U.S.C. § 102(e)

Claims 1-13, 15-18 and 20-25 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Int. Pat. Appl. Publ. WO 03/086029 to Goodwin et al. (the ‘029 publication), which is the equivalent of U.S. Pat. No. 7,438,882.

As the Examiner is well aware, in order to properly classify and rely upon a reference (i.e., a patent or a published patent application) as prior art under 35 U.S.C. § 102(e), the reference must be filed “by another.” Because the ‘029 patent is the work of one or more of the co-inventors of the subject application, as described in greater detail below, the Applicants respectfully submit that the reference relied upon by the Examiner, i.e., the ‘029 publication, is not “by another” and request the rejection under 35 U.S.C. § 102(e) be withdrawn.

In particular, the ‘029 publication is the work of Andrew James Goodwin, Stuart Leadley, Pierre Chevalier and Bhukandas Parbhoo. Because Pierre Chevalier and Bhukandas Parbhoo are co-inventors of both the ‘029 publication and the subject application, the statutory requirement for § 102(e) of “by another” is not satisfied.

The Applicants appreciate that the standard for determining whether a reference is “by another” depends on the identity of the inventive entity, as set forth in MPEP § 2136.04. Generally, “another” means other than applicants, i.e., a different inventive entity. The inventive entity is different if not all inventors are the same between the prior art reference

and the patent application at issue, which is the present scenario. However, the Examiner is respectfully reminded that in order to rely on specific teachings of any reference under § 102(e), the teachings themselves must be the work of another.

Specifically, “[t]he fact that an application has named a different inventive entity than a patent does not necessarily make that patent prior art.” MPEP § 2136.05 (citing *Applied Materials Inc. v. Gemini Research Corp.*, 835 F.2d 279 (Fed. Cir. 1988). “In fact, even if applicant’s work was publicly disclosed prior to his or her application, applicant’s own work may not be used against him or her unless there is a time bar under 35 U.S.C. 102(b).” (emphasis added) *In re DeBaun*, 687 F.2d 459, 214 USPQ 933 (CCPA 1982) (citing *In re Katz*, 687 F.2d 450, 215 USPQ 14 (CCPA 1982)). Accordingly, even if the ‘029 publication and the subject application are, in a generic sense, “by another,” the specific teachings of these references that the Examiner is relying upon are the work of one or more of the co-inventors. Thus, the teachings present in both the ‘029 publication and the subject application are the inventors’ own work and these particular teachings cannot be used in the context of a § 102(e) rejection.

In view of the foregoing, the Applicants submit that claims 1-25 are both novel and non-obvious over the prior, including over ‘029 publication. As such, the Applicants believe the subject application is in condition for allowance, and such allowance is respectfully requested.

This Amendment is timely filed; thus, it is believed that no additional fees are due. However, if necessary, the Commissioner is authorized to charge Deposit Account 08-2789

in the name of Howard & Howard Attorneys PLLC for any additional fees or to credit the account for any overpayment.

Respectfully submitted,

HOWARD & HOWARD ATTORNEYS PLLC

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